

Docket No.: 606928006US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gokhale et al.

Application No.: 09/991,900

Confirmation No.: 3389

Filed: November 23, 2001

Art Unit: 2161

For: METHOD AND SYSTEM FOR
SCHEDULING MEDIA EXPORTS

Examiner: T. Y. Chen

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in furtherance of the Notice of Appeal filed in this case on September 18, 2009.

The fees required under 37 C.F.R. § 41.20(b)(2) and any required petition for extension of time for filing this brief and fees therefore are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

INTRODUCTION

This is the second time the applicants have brought this application before the Board of Patent Appeals and Interferences (the "Board"). The applicants previously appealed a rejection of claims 1-20 by the Examiner.¹ The Board decided in the applicants' favor by reversing the Examiner's rejection (the "Board Decision").² The essence of the Board Decision was that the Examiner had not shown that the secondary reference (Baca³) used by the Examiner in the 35 U.S.C. § 103(a) rejection of the claims cured the deficiencies of the primary reference (Crouse⁴). (See Board Decision at p. 7, lines 13-23.) More particularly, the Board found that Baca did not disclose identifying a specified time at which removable media (e.g., magnetic tapes) are scheduled to be exported (e.g., from an automated tape library), and then exporting the tapes at that specified time. (*Id.*) Therefore, the Board reversed the Examiner's rejection of the claims. (Board Decision at p. 8, lines 9-10.)

The Examiner subsequently mailed a Notice of Allowance allowing claims 1-20. Pursuant to their duty of disclosure, the applicants filed a Request for Continued Examination and an Information Disclosure Statement on June 27, 2008, but did not amend or cancel any of the claims. The Examiner twice rejected the claims under Section 103(a), each time relying again on Crouse as the primary reference, but now substituting for Baca a new secondary reference (Sitka⁵). As explained below, Sitka is at best cumulative or redundant to the teachings of Baca. In rejecting the claims, the Examiner used the exact same rationale of previous Office Actions for combining the references (which rationale the Board correctly rejected), but simply replaced Baca with Sitka. After arguing against the first rejection (without amending or canceling any of the

¹ The applicants filed a first Notice of Appeal on June 20, 2006 appealing the Examiner's final rejection of claims 1-20 under 35 U.S.C. § 103(a).

² Board Decision on Appeal, decided April 11, 2008, appeal No. 2008-1254.

³ U.S. Patent No. 5,898,593.

⁴ U.S. Patent No. 5,764,972.

⁵ U.S. Patent No. 6,330,572.

claims), the applicants filed a second Notice of Appeal, to which this appeal brief pertains.

The applicants sincerely regret that the actions of the Examiner require the Board to revisit an issue that the Board has essentially already considered (and decided for the applicants). The essence of the outstanding rejection is that the Examiner has recycled old arguments as to why the claims are obvious, but modified them by replacing Baca with Sitka. However, as this brief makes clear, Sitka, like Baca before it, does not cure the deficiencies of Crouse. Sitka, like Baca before it, does not teach or suggest scheduling the export of removable media and exporting the removable media according to the schedule. Accordingly, the combination of the Crouse and Sitka, like the Examiner's previous combination of Crouse and Baca, cannot support a rejection of claims 1-20 under Section 103(a). For at least this reason, the applicants respectfully request that the Board reverse the Examiner's rejection of claims 1-20 under Section 103(a).

BODY

This brief contains, under the appropriate headings and in the order indicated, the following items as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.02:

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to Be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is CommVault Systems, Inc.

II. RELATED APPEALS AND INTERFERENCES

As noted above, the Board Decision reversed the Examiner's final rejection of claims 1-20. A copy of the Board Decision is in the Related Proceedings Appendix.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 20 claims pending in the application.

B. Current Status of Claims

- 1. Claims canceled: none.
- 2. Claims withdrawn from consideration but not canceled: none.
- 3. Claims pending: 1-20.
- 4. Claims allowed: None.
- 5. Claims rejected: 1-20.

C. Claims on Appeal

The claims on appeal are claims 1-20.

IV. STATUS OF AMENDMENTS

The applicants have not filed any amendments after the Office Action mailed May 18, 2009. The applicants have not amended the claims since the Board Decision.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, including a chart summarizing instances where support for each of the independent claims may be found in the specification:

A. Independent Claim 1

Claim 1 is directed to a method for exporting removable media in a storage device according to a schedule. The storage device receives export identification data, such as first data identifying one or more removable media from the storage device to be exported. The system also receives second data identifying a second time at which the one or more removable media are scheduled to be exported. The storage device stores the export identification data in a data file. At the second time, the storage device uses the stored export identification data to select the one or more removable media to be exported to export the selected media from the storage device library. Support for claim 1 is found, for example, at page 6, line 16 to page 7, line 3 of the applicants' specification.

B. Independent Claim 12

Claim 12 is directed to an administrative system for scheduling an export of one or more removable media from a storage device. The system includes a user interface for receiving, at a first time, export identification data comprising first data identifying one or more removable media from the storage device to be exported. The user

interface also receives second data identifying a second time at which the identified one or more removable media are scheduled to be exported. The system includes a data file stored in a memory device for storing the export identification data. Furthermore, the system includes a task control subsystem for retrieving the export identification data at the second time from the data file and controlling the storage device to cause the export of the removable media identified by the media identification data. Support for claim 12 is found, for example, at page 5, line 19 to page 6, line 3 of the applicants' specification.

C. Independent Claim 18

Claim 18 is directed to a data structure stored on a computer readable medium that includes first data identifying one or more removable media from a storage device and second data identifying a time at which the identified one or more removable media are scheduled to be exported from the storage device. The data structure is accessed by a task control application program at the second time to determine which one or more removable media are scheduled to be exported at the second time. The data structure is also accessed to send a control signal to the storage device to initiate export of the identified one or more removable media. Support for claim 18 is found, for example, at page 6, lines 4-12 of the applicants' specification.

D. Summary of Exemplary Sections of the Specification

| <i>Claim</i> | <i>Specific Section(s) of the Specification</i> |
|--------------|---|
| 1 | Page 6, line 16 to page 7, line 3. |
| 12 | Page 5, line 19 to page 6, line 3; page 7, line 19 to page 8, line 8. |
| 18 | Page 6, lines 4-12. |

Computer systems often back up or copy data to removable media, which may be stored in media libraries. Examples of removable media are magnetic tapes and optical disks. Media libraries contain equipment such as automated arms that move and export removable media to and from these libraries. For example, media libraries may export a magnetic tape out of a library when that tape is to be archived and sent to an off-site location. (See, e.g., applicants' specification at page 5, lines 5-14.)

Computer systems may be physically separated from a media library. In these cases, the system may send control signals to the library to export a magnetic tape or optical disk. The control signals may invoke mechanical movements within the library, such as an automated arm moving to a tape, gripping the tape, moving the tape to an export bin, and dropping the tape into the export bin. There may be a delay between receiving a command to export the tape and the actual exporting of the tape. Conventional systems may not always be able to export media from a library immediately after receiving such requests from administrators. For example, conventional systems may assign all command requests to a queue (e.g., read, write, and export requests), and process the various requests via the queue, regardless of importance or timing issues. (See, e.g., applicants' specification at page 4, lines 14-20.) Accordingly, conventional systems may determine an exportation time for a medium according to the queue, which is a time dictated by "as soon as possible."

Systems and methods of the present invention improve over prior systems in part by not being bound by a command request queue. Examples of the present invention allow a library to export tapes according to a schedule (e.g., based on time of day or day of the week). The system may receive both (1) data that identifies a tape to be exported from the library and (2) data that indicates a time when the tape is scheduled to be exported. The system may then use the identification data and the scheduling data for exporting the tape at the scheduled time. (See, e.g., applicants' specification at page 3, lines 5-15.) For example, the system may receive instructions from a system

administrator that identifies tapes to be exported and the day and time to export them. The system may then export the tapes at the scheduled day and time.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The Examiner's Rejections

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) over the combination of U.S. Patent No. 5,764,972 to Crouse et al. ("Crouse") and U.S. Patent No. 6,330,572 to Sitka ("Sitka").

B. The Issues on Appeal

Whether claims 1-20 are unpatentable under 35 U.S.C. § 103(a) over the combination of Crouse and Sitka.⁶

VII. ARGUMENT

Claims 1-20 Are Patentable Under 35 U.S.C. § 103(a) Over the Combination of Crouse and Sitka

Claims 1-20 are patentable under 35 U.S.C. § 103(a) over the combination of Crouse and Sitka for a number of reasons. One reason is that Crouse and Sitka do not teach or suggest all of the features of each of claims 1-20. For example, independent claim 1 recites, *inter alia*, "at a first time, receiving . . . second data identifying a second time at which the one or more removable media is scheduled to be exported." Independent claims 12 and 18 include similar features. Neither Crouse nor Sitka teaches or suggests scheduling an export of removable media and exporting the removable media according to the schedule. Rather, Crouse describes techniques for archiving files and Sitka describes techniques for managing the storage of files. Nothing in either Crouse or Sitka corresponds to scheduling the export of removable

⁶ The appellants have grouped the claims to simplify issues on appeal. The appellants, however, do not admit that the claims in any group stand or fall together for purposes other than this appeal. In particular, the appellants reserve the right to argue the patentability of each claim separately in a subsequent action, such as reopened prosecution or litigation.

media and exporting the removable media according to the schedule (e.g., a user-specified time).

A second reason is that there is no teaching, suggestion, or motivation to modify Crouse in the manner proposed by the Examiner. Another reason is that the Examiner has not clearly articulated why claims 1-20 would have been obvious. For at least these reasons, claims 1-20 are patentable over the combination of Crouse and Sitka under 35 U.S.C. § 103(a). Accordingly, the Board should reverse the Examiner's rejection of claims 1-20.

A. Legal Requirements for Obviousness

35 U.S.C. § 103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In the case of *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007), the Supreme Court reaffirmed the framework set forth in *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (U.S. 1966), for applying the statutory language of § 103(a). The *Graham* framework requires that the Examiner perform the following analysis:

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."

KSR, 82 U.S.P.Q.2d at 1391 (quoting *Graham*, 148 U.S.P.Q. at 467).

As a preliminary matter, the Examiner has not analyzed any of claims 1-20 in accordance with the *Graham* framework, for at least the reason that the Examiner has not resolved the level of ordinary skill in the pertinent art, as required by *Graham* and *KSR*.

The M.P.E.P. provides exemplary rationales that can support a conclusion of obviousness, including: (1) "[c]ombining prior art elements according to known methods to yield predictable results" and (2) "[s]ome teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." M.P.E.P. § 2143. It appears that the Examiner used either or both of these rationales to support the rejections of the claims under 35 U.S.C. § 103(a) in the Office Action mailed May 18, 2009 (the "Office Action").

To reject a claim based on the first rationale, after resolving the *Graham* factual inquiries, the Examiner must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

M.P.E.P. § 2143. "If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art." *Id.* As the following will make clear, all of these findings cannot be made because all the claimed features were not described in the applied references. Therefore, claims 1-20 cannot be rejected under 35 U.S.C. § 103(a) using this rationale.

To reject a claim based on the second rationale, after resolving the *Graham* factual inquiries, the Examiner must articulate the following:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success;
and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

M.P.E.P. § 2143. "If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art." *Id.* As the following will make clear, all of these findings cannot be made because there is no teaching, suggestion, or motivation to modify the applied references in the manner proposed by the Examiner. Therefore, claims 1-20 cannot be rejected under 35 U.S.C. § 103(a) using this rationale.

B. The Applied References

1. Crouse

Crouse is directed to an archiving file system for data servers in a distributed network environment. Crouse describes an archiving file system that automatically archives remote files across multiple types of media on network data servers. (Crouse at Abstract.) According to Crouse, "it would be desirable to provide a file system that automatically manages the long-term storage and retrieval of large volumes of data as part of a network data server across multiple types of secondary storage media." (Crouse at 4:10-13.) Crouse describes a "unique archiving file structure" that "is a flexible control structure that is used for storing control information about the remote files as part of an addressable control file." (Crouse at 4:43-50.)

2. Sitka

Sitka is directed toward a system and method for managing the storage of files within a hierarchical storage management (HSM) system. (Sitka at 1:64-65.) Sitka's system, termed a directed storage management (DSM) system, allows the ability to direct files to particular locations. (Sitka at 8:12-18.) The DSM system is described as especially useful for managing the storage of larger files, such as image files. (Sitka at 1:64-67.)

C. Claims 1-20: The Combination of Crouse and Sitka Does Not Support a Finding That the Prior Art Included Each Element Claimed

As noted above, to reject claims 1-20 based on the rationale that the features of these claims are described in the applied references, and can simply be combined according to known methods to yield predictable results, the Examiner must make a finding that the applied references included each feature in the claims. However, the Examiner cannot make this finding because the applied references do not teach all the features of these claims.

Claim 1 is directed to a method for exporting removable media in a storage device according to a schedule. The method includes, *inter alia*, "at a first time, receiving . . . second data identifying a second time at which the one or more removable media is scheduled to be exported" and "at the second time, using the stored export identification data to select the one or more removable media to be exported to export the selected media from the storage device library." In other words, claim 1 recites receiving data that affirmatively identifies a specific time when removable media (e.g., a magnetic tape) is later scheduled to be exported from a storage device (e.g., from an automated tape library.) Independent claims 12 and 18 include similar features.

Crouse does not disclose or suggest scheduling the export of removable media and exporting the removable media according to the schedule. Rather, Crouse describes an archiving file system that automatically archives remote files across multiple types of media on network data servers. In the Office Action, the Examiner recognized that Crouse does not disclose or suggest scheduling the export of removable media and exporting the removable media according to the schedule. (Office Action at p. 3: "Crouse did not specifically disclose the file input/output commands including a scheduling of an exporting processing.") Furthermore, the Board Decision implicitly accepted that Crouse does not disclose or suggest scheduling the export of removable media and exporting the removable media according to the schedule. (See Board Decision, p. 6, lines 14-16.)

To cure these deficiencies, the Examiner states that Sitka describes a data storage system that automatically schedules import and export commands for removable devices. (Office Action at p. 3.) The Examiner is incorrect. Like Baca before it, Sitka does not describe scheduling the export of removable media and then exporting the removable media according to the schedule. Rather, Sitka describes migrating files between media. Sitka also describes exporting a volume upon reaching some threshold storage capacity. However, Sitka does not disclose or suggest that the volume is scheduled for export and exporting the volume at a scheduled time. In fact,

one of skill in the art would understand Sitka to describe exporting the volume as soon as possible.

As noted above, Sitka describes a DSM system that allows files to be directed between particular locations. Sitka describes the migration of files between media in the DSM system. (See Sitka at 8:44-46 (defining migration as automatic movement of files between stores, which are collections of like media).) Sitka describes that a migration policy may set a period of time (a migration time window) in which to carry out a migration of files. (Sitka at 17:44-53.) A migration agent monitors a store, selects files to be migrated from the store, and schedules the migration. (Sitka at 24:4-19.) The actual migration of the files from the store may happen during a preset time window, such as overnight. (Sitka at 25:15-22.)

However, scheduling a migration of files from one store to another does not correspond to scheduling the export of removable media, for several reasons. A first reason is that a file is not a removable medium. The applicants' specification gives examples of removable media: magnetic tapes and optical disks. (See applicants' specification at paragraph [0024].) In contrast, Sitka defines a file as "a user-defined blob of information that can be stored in DSM system 10." (Sitka at 8:38-39.) A removable medium such as a magnetic tape or optical disk is not user-defined; rather, it is a physical, tangible item. A user-defined blob of information is simply electronic data contained on a data storage device. No person of ordinary skill in the art would equate a user-defined blob of information with a removable medium. Because a file is not a removable medium, scheduling a migration of files does not correspond to scheduling the export of removable media.

A second reason is that migrating a file does not correspond to exporting a removable medium. In Sitka's system, migrating a file from one store to another store involves copying the electronic data from a first collection of media to a second collection of media. In other words, the electronic data is replicated from the first collection of media to the second collection of media. Replicating electronic data, a

process which can be repeated *ad infinitum*, is not the same as exporting a removable medium from a media library, a process which may occur only once without reimporting the removable medium. Because replicating electronic data is not the same as exporting a removable medium, scheduling a migration of files from one store to another does not correspond to scheduling the export of removable media.

Sitka uses the term "export" in the context of exporting a volume. (See Sitka at 26:14-27.) Sitka describes that an agent can merge the oldest files on multiple volumes onto a single volume for export. (Sitka, 26:23-26.) Sitka states: "When the library capacity reaches some threshold, an agent will combine the oldest files on loaded volumes onto a single volume for export. That volume can then be exported and a fresh volume can be imported." (Sitka, 26:24-27.) Accordingly, Sitka describes exporting a volume upon reaching some threshold storage capacity. Like Baca before it, Sitka makes no mention of scheduling the export of the volume. Therefore, one of ordinary skill in the art would understand that once the volume can be exported from the library, the exportation occurs as soon as possible. The Board previously concluded that a time hinging on as soon as possible is distinguishable from "second data identifying a second time at which the one or more removable media is scheduled to be exported," as recited in claim 1. (Board Decision at p. 7, lines 20-23.) Accordingly, Sitka's exporting a volume as soon as possible does not correspond to scheduling the export of removable media and exporting the removable media at the scheduled time.

Based on the foregoing, it is clear that Crouse and Sitka, either individually or collectively, do not teach or suggest "at a first time, receiving . . . second data identifying a second time at which the one or more removable media is scheduled to be exported" and "at the second time, using the stored export identification data to select the one or more removable media to be exported to export the selected media from the storage device library." Therefore, the Examiner cannot make a finding that the prior art includes each element claimed. Accordingly, the Examiner cannot reject claims 1-20 based on the rationale that the features of these claims are described in the applied

references and can simply be combined according to known methods to yield predictable results.

D. Claims 1-20: There Is No Teaching, Suggestion, or Motivation to Modify Crouse in the Manner Proposed by the Examiner

As noted above, to reject claims 1-20 based on the rationale that there is some teaching, suggestion, or motivation in the applied references to modify or combine them to arrive at claims 1-20, the Examiner must make a finding that there was some teaching, suggestion, or motivation, either in the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the applied references or to combine their teachings. However, there is no such teaching, suggestion, or motivation in the applied references to modify or combine them in the manner proposed by the Examiner.

Crouse describes an automated media loader (AML) module that is responsible for scheduling the mounting of a requested medium contained within a storage library, so that remote files on the requested medium may be accessed. (Crouse at 20:22-26, 20:40-63.) As the Examiner correctly notes, Crouse does not teach or suggest scheduling the export of removable media. (Office Action at p. 3.) Moreover, Crouse contains no indication that it would be desirable to schedule the export of the requested medium from the storage library or to export the requested medium according to a schedule. Even if a person of ordinary skill in the art were to read Crouse and wish to implement scheduling of the export of a medium from the storage library, that person would not turn to Sitka. This is because, as set forth above, Sitka does not teach or suggest scheduling the export of removable media. Moreover, Sitka also does not contain any indication that it would be desirable to schedule the export of a removable medium or to export the removable medium according to a schedule. Therefore, there is no such teaching, suggestion, or motivation in either Crouse or Sitka to modify or combine them to arrive at claims 1-20. The Examiner has not put forth evidence that such a teaching, suggestion, or motivation was part of the knowledge generally available to a person of ordinary skill in the art.

Therefore, the Examiner has also not carried the burden of making a finding that there was some teaching, suggestion, or motivation, either in the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the applied references or to combine their teachings. Accordingly, the Examiner cannot reject claims 1-20 based on the rationale that there is some teaching, suggestion, or motivation in the applied references that would have led one of ordinary skill to modify the applied references or to combine their teachings to arrive at claims 1-20.

E. The Examiner Has Not Clearly Articulated Reasons Why Claims 1-20 Would Have Been Obvious

According to the M.P.E.P., "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2143. The Examiner has not clearly articulated why claims 1-20 would have been obvious. Rather, the Examiner has merely repurposed old arguments that the Board previously rejected. In the Office Action of January 20, 2006 (containing the rejection from which the applicants first appealed), the Examiner made the following statement:

Crouse and Baca are in the common field to process file input/output operations via a common interface, therefore, with the teachings of Crouse and Baca in front of him/her, an ordinary skilled person in the art at the time the invention was made would have been motivated to modify Crouse's user interface with the import and export commands as disclosed by Baca, because by doing so, the combined system will facilitate a system user to schedule the import or export operation with ease.

(Office Action of January 20, 2006 at pp. 3-4.)

In comparison, see the statement made by the Examiner in the Office Action containing the rejection from which this appeal is taken:

Crouse and Sitka are in the common field to process file input/output operations via a common interface, therefore, with the teachings of Crouse and Sitka in front of him/her, an ordinary skilled person in the art at the time the invention was made would have been motivated to modify Crouse's user interface with the import and export commands as disclosed by Sitka, because by doing so, the combined system will facilitate a system user to schedule the import or export operation with ease.

(Office Action at pp. 3-4.) It is easily seen that the Examiner created a new rationale for combining Crouse and Sitka by merely recycling the old rationale (which the Board correctly rejected) and substituting Sitka for Baca. In other words, the Examiner simply changed the word "Baca" to "Sitka."⁷ Modifying a rejected rationale by replacing one deficient reference with another deficient reference does not result in a clear articulation of why claims 1-20 are obvious. Rather, like the old rationale, the new rationale is inarticulate, speculative, and unsupported by the evidence. By reversing the Examiner's previous rejection in its previous decision, the Board correctly rejected the Examiner's arguments. The Board should reject those same arguments again and reverse the Examiner's current rejection of claims 1-20.

VIII. CLAIMS APPENDIX

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

IX. EVIDENCE APPENDIX

The evidence appendix is attached hereto as Appendix B.

X. RELATED PROCEEDINGS APPENDIX

The related proceedings appendix is attached hereto as Appendix C.

⁷ The Examiner set forth the same rationale in the Office Action of August 18, 2008. See p. 4.

CONCLUSION

For at least the above reasons, each of pending claims 1-20 has been improperly rejected. There are no rationales that can be used to support a conclusion that the pending claims would have been obvious to one of ordinary skill in the art. Furthermore, the Examiner has not clearly articulated why the pending claims would have been obvious. Therefore, the pending claims cannot be rejected under 35 U.S.C. § 103(a). Accordingly, the Board should reverse the Examiner's rejection of pending claims 1-20.

Please charge any deficiency in fees or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 606928006US from which the undersigned is authorized to draw.

Dated: January 19, 2009

Respectfully submitted,

By 

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/991,900

1. (Previously Presented) A method for exporting removable media in a storage device according to a schedule, comprising:
at a first time, receiving export identification data comprising first data identifying one or more removable media from the storage device to be exported and second data identifying a second time at which the one or more removable media is scheduled to be exported;
storing the export identification data in a data file; and
at the second time, using the stored export identification data to select the one or more removable media to be exported to export the selected media from the storage device library.
2. (Previously Presented) The method of claim 1, wherein receiving export identification data comprises receiving a list of one or more removable media.
3. (Previously Presented) The method of claim 2, wherein receiving a list of one or more removable media comprises receiving a list of removable media identifiers.
4. (Previously Presented) The method of claim 1, wherein receiving export identification data comprises receiving one or more removable media selection criteria.
5. (Previously Presented) The method of claim 4, wherein using the stored export identification data to select the one or more removable media to be exported comprises evaluating the stored removable media selection criteria to determine which of the removable media in the library meets the one or more removable media selection criteria.

6. (Previously Presented) The method of claim 4, wherein receiving one or more removable media selection criteria comprises receiving a criteria defined by a length of time since a removable media was last read from or written to.

7. (Original) The method of claim 1, wherein storing the export identification data comprises storing the export identification data in an administrative task parameter table.

8. (Original) The method of claim 7, comprising accessing the administrative task parameter table at the second time to retrieve the identification data.

9. (Previously Presented) The method of claim 1, comprising storing an export history table containing a plurality of fields identifying the removable media to be exported and a status of the export of each such removable media.

10. (Previously Presented) The method of claim 8, comprising updating the export history table following an attempt to export the removable media from the storage device.

11. (Previously Presented) The method of claim 1, comprising receiving an instruction to halt or delay an export and halting or delaying the export.

12. (Previously Presented) An administrative system for scheduling an export of one or more removable media from a storage device, the system comprising:

a user interface for receiving, at a first time, export identification data comprising first data identifying one or more removable media from the storage device to be exported and second data identifying a second time at which the identified one or more removable media is scheduled to be exported;

a data file stored in a memory device for storing the export identification data;
and
a task control subsystem for retrieving the export identification data at the second time from the data file and controlling the storage device to cause the export of the removable media identified by the media identification data.

13. (Previously Presented) The system of claim 12, wherein the user interface is configured to allow a user to specify one or more removable media to be exported by one or more respective removable media identifiers, the data file storing the specified removable media identifiers.

14. (Previously Presented) The system of claim 12, wherein the user interface is configured to allow a user to specify one or more criteria by which removable media is selected to be exported, the database storing the specified one or more criteria.

15. (Previously Presented) The system of claim 14, wherein the task control subsystem comprises an evaluator for evaluating the stored criteria to determine which one or more removable media in the storage device satisfy the specified one or more criteria at the second time.

16. (Previously Presented) The system of claim 12, comprising an export history data file stored in a memory device, the export history data file containing a field associated with each removable media indicating a status of the export of the removable media.

17. (Previously Presented) The system of claim 12, wherein the user interface is configured to allow a user to specify second data comprising a specified event following which the removable media is to be exported.

18. (Previously Presented) A data structure stored on a computer readable medium comprising first data identifying one or more removable media from a storage device and second data identifying a time at which the identified one or more removable media are scheduled to be exported from the storage device, the data structure being accessed by a task control application program at the second time to determine which one or more removable media are scheduled to be exported at the second time and to send a control signal to the storage device to initiate export of the identified one or more removable media.

19. (Previously Presented) The data structure of claim 18, wherein the first data comprises a list of one or more removable media identifiers.

20. (Previously Presented) The data structure of claim 19, wherein the first data comprises one or more criteria by which one or more removable media is selected to be exported at the second time.

APPENDIX B

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by or relied upon by the Examiner is being submitted.

APPENDIX C

The applicants attach a copy of the Board Decision of April 11, 2008.



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| 09/991,900 | 11/23/2001 | Parag Gokhale | 4982/23 | 3389 |
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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* PARAG GOKHALE, RAJIV KOTTOMTHARAYIL,
9 and SRINIVAS KAVURI
10

11
12 Appeal 2008-1254
13 Application 09/991,900¹
14 Technology Center 2100
15

16
17 Decided: April 11, 2008
18
19

20
21 Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
22 CAROLYN D. THOMAS, *Administrative Patent Judges*.

23
24 THOMAS, C., *Administrative Patent Judge*.
25

26 DECISION ON APPEAL

¹ Application filed November 23, 2001. The real party in interest is CommVault Systems, Inc.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-20 entered January 20, 2006. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

Appellants invented a system, method, and computer readable medium for exporting media in a library according to a scheduled second time. (Spec., Abstract.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-20. Claims 1, 12 and 18 are independent claims. Claim 1 is illustrative:

1. A method for exporting removable media in a storage device according to a schedule, comprising:
 - at a first time, receiving export identification data comprising first data identifying one or more removable media from the storage device to be exported and second data identifying a second time at which the one or more removable media is scheduled to be exported;
 - storing the export identification data in a data file; and
 - at the second time, using the stored export identification data to select the one or more removable media to be exported to export the selected media from the storage device library.

1 C. REFERENCES

2 The references relied upon by the Examiner in rejecting the claims on
3 appeal are as follows:

| | | |
|----------|--------------|---------------|
| 4 Crouse | US 5,764,972 | Jun. 9, 1998 |
| 5 Baca | US 5,898,593 | Apr. 27, 1999 |

6
7 D. REJECTION

8 The Examiner entered the following rejection which is before us for
9 review:

10 Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being
11 unpatentable over Crouse in view of Baca.

12
13 II. PROSECUTION HISTORY

14 Appellants appealed from the Final Rejection and filed an Appeal
15 Brief (App. Br.) on March 19, 2007. The Examiner mailed an Examiner's
16 Answer (Ans.) on July 17, 2007. Appellants filed a Reply Brief (Reply Br.)
17 on September 17, 2007. A telephonic Oral Hearing was held at the U.S.
18 Patent and Trademark Office on April 8, 2008.

19
20 III. ISSUE

21 Whether the combination of Crouse and Baca would have suggested
22 exporting media according to a scheduled second time.

23
24 IV. FINDINGS OF FACT

25 The following findings of fact (FF) are supported by a preponderance
26 of the evidence.

Baca

1
2 1. Baca discloses “an automated data storage library for storage,
3 retrieval, selective export and import of portable data storage media, at least
4 some of the media stored in storage cells of portable magazines.” (Col. 2, ll.
5 3-6.)

6 2. In Baca, “the library controller 82 is able to employ a cartridge
7 identifier in a command from a host 85 to identify the magazine containing
8 the cartridge, and the storage slot location of the cartridge, determine the
9 location of any cartridge in a drive, and the current position of the pickers.
10 This information is used in conjunction with job queue contents by the
11 library manager to schedule picker moves and to schedule the export of
12 selected magazines.” (Col. 6, l. 62 to Col. 7, l. 3.)

13 3. Baca discloses that “[w]hen a magazine is required to be exported,
14 the host will instruct the operator that a selected magazine is ready to be
15 exported and indicate the column 90 or 91 which has the selected
16 magazine.” (Col. 7, ll. 43-46.)

17
18 V. PRINCIPLES OF LAW

19 Appellants have the burden on appeal to the Board to demonstrate
20 error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86
21 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a
22 rejection [under § 103] by showing insufficient evidence of *prima facie*
23 obviousness or by rebutting the *prima facie* case with evidence of secondary
24 indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355
25 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) wherein evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

VI. ANALYSIS

Common Feature In All Claims

Our illustrative claim presented *supra*, claim 1, recites, *inter alia*, “at a first time, receiving . . . second data identifying a second time at which the one or more removable media is scheduled to be exported.” Independent claims 12 and 18 recite similar limitations. Thus, the scope of each of the independent claims includes “the exportation of selected removable media at a second time.”

The Obviousness Rejection

We now consider the Examiner's rejection of claims 1-20 under 35 U.S.C. § 103(a) as being obvious over the combination of Crouse and Baca.

1 The question of obviousness is "based on underlying factual
2 determinations including . . . what th[e] prior art teaches explicitly and
3 inherently" *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citing
4 *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembiczak*,
5 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed.
6 Cir. 1995)). "In rejecting claims under 35 U.S.C. § 103, the examiner bears
7 the initial burden of presenting a *prima facie* case of obviousness." *In re*
8 *Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d
9 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is
10 established when the teachings from the prior art itself would appear to have
11 suggested the claimed subject matter to a person of ordinary skill in the art."
12 *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*,
13 531 F.2d 1048, 1051 (CCPA 1976)).

14 The Examiner found that "Crouse did not specifically disclose at the
15 second time, the file input/output commands including a scheduling of an
16 exporting processing." (Ans. 4.) Instead, the Examiner relies upon Baca for
17 this limitation and found that Baca "discloses a data storage system to
18 automatically scheduling [sic] an import and export I/O commands for
19 removable devices at the second time." (Ans. 5.)

20 Appellants contend that "Baca does not disclose exporting media
21 according to a schedule, as described in claim 1." (App. Br. 8.) Appellants
22 further contend that:

23 [T]he "scheduling" in Baca relates to coordinating specific
24 internal operations in the library, such as moving a picker and
25 rearranging stacks of magazines so that a desired magazine is
26 on top of a stack for exporting. The "scheduling" in Baca does
27 not disclose "identifying a second time at which the one or

1 more removable media is scheduled to be exported" as recited
2 by the claim.

3
4 (App. Br. 8-9.) We agree.

5
6 Baca discloses an automated data storage library that performs
7 selective export and import of portable data storage media (FF 1). In Baca, a
8 library controller receives a cartridge identifier in a command from a host
9 and uses this information in conjunction with the job queue contents to
10 schedule the export of selected magazines (FF 2). Baca's host instructs the
11 operator that a selected magazine is ready to be exported and indicates the
12 column that has the selected magazine (FF 3).

13 In other words, we find that while Baca discloses selectively
14 exporting data storage media using an identifier found in a command from a
15 host in conjunction with job queue information, the Examiner has not
16 shown, and we do not readily find where Baca makes up for the deficiencies
17 of Crouse and discloses receiving a second time and at the second time
18 exporting the selected media from the storage. Instead, Baca relies in part
19 on the job queue list to determine the exportation time, which is in essence a
20 time dictated by "as soon as possible". We find that a "time" hinging on "as
21 soon as possible" is distinguishable from "second data identifying a second
22 time at which the one or more removable media is scheduled to be
23 exported," as recited in the language of independent claim 1.

24 Since we agree with Appellants that the Examiner has not supported
25 the rejection of the noted claims with a teaching or suggestion from the cited
26 prior art, and as the above-noted arguments affect all the appealed claims, it
27 is not necessary at this time to address the further arguments made by
28 Appellants (e.g., App. Br. 10 and Reply Br. 5).

Therefore, we will *not* sustain and will instead reverse the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

VII. CONCLUSION

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-20.

VIII. DECISION

In view of the foregoing discussion, we reverse the Examiner's rejection of claims 1-20.

REVERSED

clj

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